IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE PATENT APPLICATION OF:	YAMANAKA *et al.*
SERIAL NO.:	10/774,629
ATTORNEY DOCKET NO.:	040803-0307870
FILING DATE:	February 10, 2004
CONFIRMATION NO.	9790
ART UNIT:	2154
EXAMINER:	KEEFER, Michael E.
FOR:	PUSH NETWORK HAVING CONTENT IDENTIFYING PACKETS

PRE-APPEAL BRIEF REQUEST FOR REVIEW

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Final Office Action mailed March 13, 2008 (hereafter "the Final Office Action"), Appellants hereby request that a panel of examiners formally review the legal and factual basis of the rejections in the above-identified application prior to the filing of an appeal brief. Appellants assert that the outstanding rejection (now on appeal by virtue of the concurrently filed Notice of Appeal) is clearly improper based upon errors in facts and the omission of essential legal elements required to establish *prima facie* rejections (i.e., the prior art references fail to disclose, teach or suggest all the recited claim features).

APPEALED REJECTIONS

A.   Claims 1-11, 14, 15, 21 and 25 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,545,982 to Murthy ("Murthy") in view of European Patent Application No. EP 0915598 to Bushmitch ("Bushmitch").

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ARGUMENTS FOR TRAVERSAL

A.   **Claims 1-11, 14, 15, 21 and 25 are patentable over Murthy and Bushmitch.**

In particular, claim 1 recites, *inter alia*, the features of:

> means within said information providing terminal for adding information to the packet;

> means within said information providing terminal for adding to the packet a content identifier or both the content identifier and a category identifier; and

> wherein the information provided by said information providing terminal is assigned a unique content identifier or both the content identifier and the category identifier for identifying the category to which the content of the information in the packet belongs.

Appellants submit that neither Murthy nor Bushmitch, either alone or in combination teach or suggest *at least* these features. For example, Murthy does not teach or suggest "means within said information providing terminal for adding information to the packet." Rather, the Examiner merely alleges that "[t]he information providing terminal must **inherently** have a means to add information to a packet, or else it would not be able to provide a packet with any information in it at all." [Final Office Action, pg. 4, **emphasis added**]. Appellants, however, are not merely claiming adding information to any packet. Rather, claim 1 specifically recites "means *within said information providing terminal* for adding information to the packet." The Examiner has failed to identify any element or feature in Murthy that corresponds to an "information providing terminal." Thus, for at least this reason, the Examiner has failed to identify any "means *within said information providing terminal* for adding information to the packet," in Murthy.

Moreover, Appellants point out that "[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic <u>necessarily</u> flows from the teachings of the applied prior art." *Ex parte Levy,* 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). The Examiner, however, has not shown that that "means *within said information providing terminal* for adding information to the

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packet," are <u>necessarily</u> provided in Murthy. For example, Murthy suggests that packets may arrive at the bridge from its ports <u>or</u> management packets may be internally generated in the bridge. [*See, e.g.*, Murthy, col. 16, lines 57-59]. Thus, the Examiner has not established with any certainty which packets of Murthy are necessarily provided from an information providing terminal.

Further, the relied-upon portions of Murthy do not teach or suggest "means within said information providing terminal for adding to the packet a content identifier or both the content identifier and a category identifier." As pointed out above, the Examiner has failed to identify any element or feature in Murthy that corresponds to an "information providing terminal." For at least this reason, the Examiner has failed to show that Murthy teaches "means **within said information providing terminal** for adding information to the packet."

The Examiner then alleges that Murthy teaches that the protocol ID, address, length field, CRC, and various packet headers in Murthy correspond to a "content ID." [*See* Final Office Action; pg. 3]. However, none of these features are related *to a category or a content of the information <u>in the packet</u>*. Indeed, claim 1 further recites that "…the information provided by said information providing terminal is assigned a unique content identifier or both the content identifier and the category identifier for identifying the category to which the content of the information in the packet belongs." Appellants point out that with the exception of data field 17 of packet 13, the various other fields of the packet are related to only aspects of packet transmission and not to the content of any information provided in the packet. [*See, e.g.*, Murthy, col. 5, lines 4-14; FIG. 2]. Further, the Packet Descriptor 49 and XMASK 55 of Murthy, which the Examiner also alleges correspond to a "content ID", do not appear to be apart of any packet either. [*See* Murthy, col. 10, lines 59-67; col. 11, lines 20-30]. Murthy merely teaches that these features are used to "… handle packets indirectly." [Murthy, col. 10, lines 60-61].

Further, even assuming *arguendo* that it was legally proper to combine the teachings of Murthy and Bushmitch (which Appellants do not concede), the relied-upon portions of Bushmitch do not overcome the deficiencies of Murthy. Indeed, the

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Examiner merely relies upon Bushmitch to allegedly "teach[] a push network and admission control of devices registering with service providers." [Final Office Action, pg. 3]. However, the relied-upon portions of Bushmitch do not teach or suggest *"means within said information providing terminal for* adding information to the packet;" and *"means within said information providing terminal for* adding to the packet a content identifier or both the content identifier and a category identifier," as recited in claim 1.

One important aspect of Appellants' claimed invention is that a content identifier, or both a content identifier and a category identifier, is/are added to the packet in the information providing terminal, along with information within the packet, so as to distribute the packets in accordance with the content/category identifiers. [*See, e.g.,* Appellants' Specification, pg. 21, lines 2-9; FIG. 1].

In striking contrast, Murthy teaches distributing packets by parsing the information contained in the data field 17. Specifically, Murthy discloses:

> When a packet arrives at a router, the Data field 17 is parsed and examined. Specific protocols are defined for each type of packet to be routed and are indicated by sub-fields in the packet Data field 17. One of the sub-fields may be a network address which is a logical, rather than a physical, address indicating the ultimate destination of the packet.

[*See* Murthy, col. 9, lines 31-34].

Indeed, this is a much more laborious process – not to mention that it does not rely upon a content identifier, or both a content identifier and a category identifier to the packet to distribute the packets, as required by claim 1.

Bushmitch also fails to teach this aspect of Appellants' claimed invention. Rather, Bushmitch teaches splitting video and audio streams into substreams, which are separately coded and transmitted over the network independently and later reconstructed by a multimedia client . [See, e.g., Buchmitch, ¶ 13].

Accordingly, Appellants submit that the cited portions of Murthy, Bushmitch, or a proper combination thereof, fail to disclose or render obvious each and every element recited by claim 1. Claims 2-11, 14, 15, 21 and 25 depend from claim 1, and are

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patentable for at least the same reasons provided above related to claim 1 and for the additional features recited therein. Thus, Appellants respectfully request that the rejections of claims 1-11, 14, 15, 21 and 25 under 35 U.S.C. § 103(a) over Murthy in view of Bushmitch should be withdrawn and the claims be allowed.

CONCLUSION

Therefore, it is respectfully requested that the panel return a decision concurring with Appellants' position and eliminating the need to file an appeal brief because there are clear legal and/or factual deficiencies in the appealed rejections. Specifically, the subject matter in claims 1-11, 14, 15, 21 and 25 is not rendered obvious by the combined teachings of Murthy and/or Bushmitch. Thus, claims 1-11, 14, 15, 21 and 25 are allowable.

Date: **June 11, 2008**   Respectfully submitted,

By: _Eric Compton (signature)_

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